

REMARKS

Claims 1-30 are currently pending in the subject application. Claim 1 is the sole independent claim.

Applicants appreciate the Examiner's acceptance of the drawings filed on September 25, 2003.

Applicants further appreciate the Examiner's consideration of applicants' Information Disclosure Statements (IDS) filed on September 25, 2003, and September 26, 2005. However, regarding the September 26, 2005 IDS, applicants note that the Examiner did not initial the Chinese reference, CN 1517296, which was included in the lower portion of the form. Accordingly, applicants respectfully request that the Examiner indicate whether CN 1517296 has been considered.

Claims 1-30 are presented to the Examiner for further prosecution on the merits.

A. Introduction

In the outstanding Office action, mailed February 22, 2006, the Examiner rejected claims 1-3, 9-17 and 21-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,914,507 to Polla et al. ("the Polla et al. reference") in view of U.S. Patent No. 6,677,709 to Ma et al. ("the Ma et al. reference") and further in view of U.S. Patent No. 6,670,212 to McNie et al. ("the McNie et al. reference"); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over the Polla et al. reference in view of the Ma et al. and McNie et al. references and further in view of U.S. Patent No. 6,245,444 to Marcus et al. ("the Marcus et al. reference"); rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over the Polla et al. and the Ma et al. references and in view of the McNie et al. reference and further in view of U.S. Patent No. 5,834,975 to Bartlett et al. ("the Bartlett et al. reference"); and objected to claims 4-7, 18-20

and 30 as being dependent upon a rejected base claim, while indicating that these claims would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

B. Asserted Obviousness Rejection of Claims 1-3, 9-17 and 21-28

In the outstanding Office Action Made Final, the Examiner rejected claims 1-3, 9-17 and 21-28 under 35 U.S.C. § 103(a) as being unpatentable over the Polla et al. reference in view of the Ma et al. reference and further in view of the McNie et al. reference. Applicants respectfully traverse this rejection.

In the amendment filed on December 14, 2005, applicants traversed the rejection of claim 1 under 35 U.S.C. § 103(a) over the Polla et al., Ma et al. and McNie et al. references. In the outstanding Office action, the Examiner responded to applicants' December 14th arguments and maintained the rejection. Applicants appreciate the Examiner's detailed response. However, applicants respectfully submit that the Examiner is mis-applying the law regarding motivation to combine, and respectfully submit that the Examiner failed to set forth a *prima facie* case of obviousness for at least the reasons set forth below:

In the outstanding Office action, the Examiner indicated that the motivation to combine the Polla et al. and Ma et al. references "comes from Ma (Ma discloses that a substrate of a MEMS device can be a flexible substrate such as polymer, thin glass or silicon)." However, applicants respectfully submit that the mere *disclosure* of a flexible substrate is insufficient to establish a motivation to combine. In particular, applicants note that the relevant inquiry is not whether the Ma et al. reference *discloses* a flexible substrate, but rather whether one of ordinary skill in the art would *desire* to combine the Ma et al. and Polla et al. references in order to arrive at the claimed invention. *See, e.g.*, MPEP § 2143.01(III), which states "[t]he mere fact that

references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination," *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). That is, establishing motivation requires the Examiner to demonstrate *why one of ordinary skill in the art, absent the teachings of applicants' application, would want to replace the silicon substrate of the Polla et al. reference with the flexible substrate of the Ma et al. reference.*

In the outstanding Office action, it appears that the Examiner is asserting that, since the Ma et al. reference discloses a flexible substrate, then the Ma et al. reference necessarily suggests using flexible substrates in other contexts. However, applicants respectfully submit that such an analysis is conclusory and improper, because it treats the motivation requirement as a simple disclosure requirement. The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Applicants respectfully submit that the Examiner has failed to provide an objective teaching that demonstrates *why* one of ordinary skill in the art would combine the Polla et al. and Ma et al. references. Accordingly, applicants respectfully submit that the Examiner has failed to set forth a *prima facie* case of obviousness with respect to claim 1, and claim 1 is believed to be allowable over the cited prior art references. The remaining rejected claims, viz., claims 2-3, 9-17 and 21-28, depend from claim 1 and are believed to be similarly allowable. Accordingly, applicants respectfully request that this rejection be reconsidered and withdrawn.

C. Asserted Obviousness Rejections of Claims 8 and 29

In the outstanding Office action, the Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over the Polla et al. reference in view of the Ma et al. and McNie et al. references and further in view of the Marcus et al. reference, and rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over the Polla et al. and Ma et al references in view of the McNie et al. reference and further in view of the Bartlett et al. reference. Applicants respectfully traverse these rejections.

Claims 8 and 29 depend from claim 1, and are therefore believed to be allowable for at least the reasons set forth above. Moreover, applicants respectfully submit that the rejections of claims 8 and 29 are not supported by objective teachings as to *why* one of ordinary skill in the art, absent the teachings of applicants' application, would combine the cited prior art references. Accordingly, applicants respectfully submit that the Examiner failed to set forth a *prima facie* case of obviousness with respect to claims 8 and 29. Therefore, applicants respectfully request that these rejections be reconsidered and withdrawn.

D. Allowable Subject Matter

In the outstanding Office action, the Examiner objected to claims 4-7, 18-20 and 30, while indicating that these claims would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicants appreciate the indication of allowable subject matter in claims 4-7, 18-20 and 30. However, applicants respectfully submit that *all* of the pending claims are allowable over the cited prior art.

E. Conclusion

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.

Respectfully submitted,

LEE & MORSE, P.C.

Date: April 14, 2006

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PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying-papers may also be charged to Deposit Account No. 50-1645.